

REMARKS

Applicants thank the Examiner for indicating that claims 24-37, 46, 47 and 59 are allowed. Claim 89 has been canceled herein. Claims 1-23, 38-45, 48-58, 60-88, and 90-95 were canceled previously. No new matter has been added by the amendments to the claims. Claims 24-37, 46, 47, and 59 will be pending after entry of this amendment. Applicants reserve the right to pursue the canceled claims in one or more continuing or divisional applications.

Formal Matters

Correction of Inventorship

Applicants respectfully note that an amendment to delete inventors Luisa Iruela-Arispe and Steven M. Ruben was included in the Preliminary Amendment filed on November 6, 2000 (see Exhibit A).

Applicants further respectfully note that a Petition Under 37 C.F.R. § 1.48(b) to Correct Inventorship in a Nonprovisional Patent Application, along with the applicable petition fee, was also filed by Applicants on November 6, 2000. A copy of the Petition is attached as Exhibit B. Specifically, Applicants petitioned to delete Luisa Iruela-Arispe and Steven M. Ruben from the inventive entity as those persons' contributions were no longer claimed as a result of amendment or cancellation of claims during prosecution of the instant application.

This information was discussed in a Request for Corrected Filing Receipt filed with the USPTO on September 30, 2005. In a "Response to Request for Corrected Filing Receipt", the Office of Initial Patent Examination indicated that it was unable to comply with the request because "[c]hanges made after submission of an executed declaration to the inventor information other than correction of typographical errors must be submitted in the form of a substitute declaration. Change of inventorship requires a petition under 37 CFR 1.48."

Applicants respectfully disagree and request reconsideration. Specifically, 37 CFR 1.48(b) states:

(b) Nonprovisional application—fewer inventors due to amendment or cancellation of claims. If the correct inventors are named in a nonprovisional application, and the prosecution of the nonprovisional application results in

the amendment or cancellation of claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed in the nonprovisional application, an amendment must be filed requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed. Amendment of the inventorship requires:

(1) A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies the named inventor or inventors being deleted and acknowledges that the inventor's invention is no longer being claimed in the nonprovisional application; and

(2) The processing fee set forth in § 1.17(i). (*Emphasis added*)

In contrast to the statement by the Office, as shown above, 37 C.F.R. § 1.48(b) does not require submission of a substitute declaration in order to correct inventorship. All that is required is: 1) an amendment requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed; 2) A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies the named inventor or inventors being deleted and acknowledges that the inventor's invention is no longer being claimed in the nonprovisional application; and 3) the processing fee set forth in § 1.17(i).

As previously indicated, prosecution of the instant application resulted in the amendment or cancellation of claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed. As a result, Applicants filed an amendment to delete inventors Luisa Iruela-Arispe and Steven M. Ruben in the Preliminary Amendment filed on November 6, 2000 (see Exhibit A); and a Petition Under 37 C.F.R. § 1.48(b) to Correct Inventorship in a Nonprovisional Patent Application, along with the applicable petition fee, on November 6, 2000. The Request was signed by a party set forth in § 1.33(b) and was accompanied by the then current fee set forth in § 1.17(i), in accordance with 37 C.F.R. § 1.48(b)(1) and 37 C.F.R. § 1.48(b)(2). Neither the original amendment nor the Request have been acted on by the Office. Applicants respectfully request that the Office consider the amendment filed on November 6, 2000 deleting inventors Luisa Iruela-Arispe and Steven M. Ruben along with the properly filed Petition Under 37 C.F.R. § 1.48(b) to Correct Inventorship in a Nonprovisional Patent Application.

Request for Corrected Filing Receipt

Applicants respectfully submit herewith a Third Request for Corrected Filing Receipt which requests (a) correction of the spelling of the name of inventor James A. Fornwald; and (b) correction of the domestic priority claim.

Claim Rejections - 35 U.S.C. §112, Written Description

Claim 89 has been rejected under 35 U.S.C. § 112, first paragraph, as allegedly “containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” *See*, Paper No. 20060428, page 2, 4th paragraph. In particular, the Examiner alleges that because the genus encompassed by claim 89 “tolerates members which minimally encode residues 1-20 of SEQ ID NO:126, wherein said members can differ radically in both structure and function from the polynucleotides encoding SEQ ID NO:126”; because the specification “describes only a single polypeptide comprising said fragment”; and because disclosure of “the polynucleotide encoding the full length SEQ ID NO:126 fails to describe the genus of polynucleotide encompassed by the claims because the genus is highly variant, that “one of skill in the art would reasonably conclude that the applicant was not in possession of the genus of claim 89 at the time of filing.” *See*, Paper No. 20060428, page 2, 4th paragraph through page 3, 1st paragraph.

Applicants respectfully traverse. Claim 89 recites a genus of polynucleotides minimally encoding residues 1-20 of SEQ ID NO:126. Applicants respectfully submit that support for this claim can be found in the specification of US Application No. 08/845,496, filed 04/24/1997, and incorporated by reference in the present application. For example, on page 8, lines 1-15, which describes that the polypeptide of the invention may be a “mature” protein or part of a larger fusion protein. In addition, fragments of the invention are described as “free-standing” or comprised within a larger polypeptide. Finally, the specific fragment of the invention (residues 1-20 of SEQ ID NO:126) is described. Further, on page 13, line 15 through page 14, line 3, the specification describes that polynucleotides of the invention may

encode the mature peptide or fragments thereof either free-standing or as part of fusion polypeptides. The specification further describes that the polynucleotide of the invention may comprise non-coding sequences in addition to encoding the polypeptide of the invention. However, in the interest of advancing prosecution, Applicants have canceled claim 89, rendering this rejection moot.

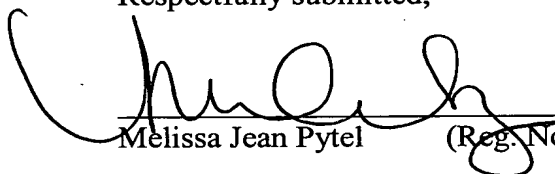
CONCLUSION

Applicants respectfully request that the remarks and amendments of the present response be entered and made of record in the present application. If any additional information is needed, Applicants respectfully request that the Examiner contact the undersigned to facilitate prosecution. The application is believed to be in condition for allowance and early notice to that effect is earnestly solicited. If a fee is required in connection with this paper, please charge Deposit Account No. 08-3425 for the appropriate amount.

Respectfully submitted,

Date:

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